Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN W. FOX and MICHAEL W. WOOD

Appeal No. 2002-0105
Application No. 09/398,891

ON BRIEF

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

John W. Fox and Michael W. Wood appeal from the examiner's final rejection of claims 1-15, all the claims pending in the application.

We reverse.

Appellants' invention pertains to a method of playing a card game on an electronic video gaming machine. An understanding of the invention can be derived from a reading

of claims 1, 5 and 12, the independent claims on appeal, which appear in the Appendix to appellants' main brief.

The sole reference relied upon by the examiner in the final rejection is:

Moody	6,007,066	Dec. 28, 1999

Claims 1-15 stand rejected "under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Moody (066)" (answer, page 3).

Reference is made to appellants' main and reply briefs (Paper Nos. 9 and 13) and to the examiner's final rejection and answer (Paper Nos. 5 and 12) for the respective positions of appellants and the examiner regarding the merits of this rejection.

Discussion

Independent claim 1 is directed to a method of playing a card game on an electronic video gaming machine in which a single player plays against a pay table. The method includes the step of dealing face up a first five card hand of poker *in a first poker format,* and the step of dealing face up a second five card hand of poker *in a second poker format different from the first poker format*. Independent claim 12 contains similar limitations. Independent claim 5 includes the steps of dealing face up four (4) hands of poker, each in a different format, the formats being Jacks or Better, Bonus Poker, Deuces Wild, and Joker Poker. As stated by appellants' (main brief, page 2) "[t]he idea is that the player can play different poker format games at the same time."

Moody pertains to electronic video poker games. As explained in the abstract:

> The method . . . involves a card game in which at least two rows of cards, and preferably three rows, are dealt to a player. The player makes a wager for each row of cards. All three rows of cards are dealt face up with each row having the same cards by rank and suit. The player selects none, one or more of the face up cards from one of the rows as cards to be held. The cards that are held are also held in all of the other rows. Replacement cards for the non-selected cards are dealt into each row. The poker hand ranking of each five card hand by row is determined. The player is then paid for any winning poker hands based on a pay table and the amount of the player's wager.

Moody discloses many game variations, "with the common thread being that cards are duplicated from a first row of cards into one or more additional rows to allow the player the opportunity to play one or more cards from the staring [sic] row of cards multiple times" (column 1, lines 23-26).

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *See In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In the present case, the examiner has not met her initial burden of establishing a *prima facie* case of anticipation or obviousness. Concerning anticipation, the examiner has not pointed out where Moody discloses, either expressly or under the principles of inherency, the requirement, found in one form or another in each of the independent

claims, of dealing a first five card hand in a first poker format, and dealing a second five card hand in a second poker format different from the first poker format. In this regard, the examiner's statement that "Moody shows a variety of poker formats in different embodiments" (answer, page 3) does not provide a basis for sustaining the standing rejection to the extent it is based on 35 U.S.C. § 102(b). This is so because alternate embodiments of the same reference cannot be combined to support an anticipation rejection under 35 U.S.C. § 102(b). *In re Arkley,* 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972). Furthermore, the examiner's statement that "Moody's claim 3 is written broad enough to encompass the teachings of different poker formats . . . . Based on the scope of claim 3, Moody therefore would anticipate claims 1, 5 and 12" (answer, pages 3-4) also does not provide a basis for sustaining the standing rejection to the extent it is based on 35 U.S.C. § 102(b). The circumstance that a prior art claim may be broad enough to read on a claimed invention does not require a conclusion of anticipation (or obviousness) since a patent's claims are not a technical description of the disclosed invention. *See In re Benno*, 768 F.2d 1340, 1345-46, 226 USPQ 683, 686 (Fed. Cir. 1985) and *In re Vamco Mach. & Tool, Inc.*, 752 F.2d 1564, 1577 n.5, 224 USPQ2d 617, 625 n.5 (Fed. Cir. 1985). Simply stated, the examiner has not pointed to anything in the disclosure of Moody that supports a conclusion that the subject matter of the appealed claims is anticipated by Moody.

As to the question of obviousness, the examiner has not identified what claim limitation Moody may lack[1], much less where Moody teaches or suggests the missing limitation and why it would have been obvious to one of ordinary skill in the art to provide such missing limitation in Moody's method. Accordingly, the examiner's alternative theory that the subject matter of the appealed claims would have been obvious in view of Moody also cannot be sustained.

In light of the foregoing, we shall not sustain the standing rejection of claims 1-15 as being anticipated by or, in the alternative, as obvious over Moody.

Remand

This case is remanded to the examiner for consideration of the follow matters.

As noted by the examiner, Moody discloses a variety of poker formats. For example, in discussing Figures 1 and 2, Moody states that "suitable payout schedules" (i.e., "schedules" in the plural) are used for both paying out a "stud hand" and a "draw poker hand," and that alternatively first and second progressive jackpot amounts can be provided for respective first and second Royal Flush hands achieved in a stud poker hand and a draw poker hand (column 3, lines 53-61).

[1]Presumably, the examiner considers that Moody may perhaps lack a teaching of dealing a first five card hand of poker in a first poker format, and dealing a second five card hand of poker in a second poker format different from the first poker format.

In discussing "Version #2H" shown in Figures 14 and 15, Moody states (column 9, lines 1-7) that in the multiple deck embodiment, one or more cards may alternatively be designated as wild cards or one or more Jokers may be added to the decks and designated as wild cards, such that the method of Moody's patent may be applied to "any of the various wild card video poker games that are known in the art, such as Deuce's Wild or Joker's Wild."

In discussing "Version #2J" at column 11, lines 29-48, Moody states that five rows of cards may be played, which "also creates additional five card stud hands of replacement cards in each of the vertical columns" such that "[s]pecial payouts or progressive or non-progressive jackpots may be awarded for high ranking stud hands that may be formed in these vertical columns."

In discussing "Version #2L", Moody states at column 13, lines 3-9, that

> In addition to five card rows, the method of the present invention can also be applied to six, seven or more card rows. Winning hand combinations can be based on six card poker hand[s], seven card poker hands or even more card poker hands. Alternatively, the winning hand combination can be based on the best five card poker hand out of the six, seven or even more cards in the row.

At column 16, lines 12-55, Moody states that the concepts of the invention disclosed therein may be extended to other known casino games such as CARIBBEAN STUD® poker[2], LET IT RIDE® poker[3] or Texas Hold 'Em poker. It is explained at column

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[2]The game of CARIBBEAN STUD® poker is described in U.S. Pat. No.

(continued...)

16, lines 23-45, that the games of CARIBBEAN STUD® poker and LET IT RIDE® poker allow for additional separate wagers based on the dealer's five card stud hand and payouts of this additional wager in accordance with a separate pay table. It is explained at column 16, lines 46-55, that a similar additional separate wager can be placed in Texas Hold 'Em poker based on the poker hand value of the five community cards utilized in the play of that game.

The examiner should consider whether any of the above disclosures may be fairly regarded as an anticipation of one or more of appellants' claims. For example, with respect to Moody's disclosure at column 3, lines 47-61, the examiner should consider whether "draw poker" and "stud poker" qualify as first and second different poker formats. A similar inquiry should be made with respect to Moody's disclosure at column 11, lines 29-48, of playing horizontal rows of cards in accordance with the general principles of Moody's invention and in addition playing vertical columns of cards as five card stud hands.[4]

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[2](...continued)
4,836,553, the disclosure of which is incorporated by reference into the Moody patent.

[3]The game of LET IT RIDE® poker is described in U.S. Pat. No. 5,288,051, the disclosure of which is incorporated by reference into the Moody patent.

[4]In addressing these issues, the examiner should determine what constitutes the broadest reasonable interpretation of the claim terminology "first poker format" and "second poker format different from the first poker format" when said terminology is read in light of appellants' disclosure.

In addition, the examiner should consider whether the above disclosures, including Moody's disclosure that the concepts of the invention may be extended to other known casino games such as CARIBBEAN STUD® poker, LET IT RIDE® poker or Texas Hold 'Em poker, would have suggested to one of ordinary skill in the art that Moody's method may be extended to include contemporaneously playing first and second different poker formats, such that one or more of appellants' claims would have been obvious in view of Moody's teachings, when taken either alone or in combination with other prior art of which the examiner may be aware. In considering this issue, the examiner should read U.S. Pat. No. 4,836,553 and U.S. Pat. No. 5,288,051, which have been expressly incorporated by reference into the disclosure of Moody, in order to determine precisely how CARIBBEAN STUD® poker and LET IT RIDE® poker, respectively, are played.

Summary

The rejection of the appealed claims under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) is reversed.

Accordingly, the decision of the examiner finally rejecting the appealed claims is reversed.

This case is remanded to the examiner for action in the matters discussed above.

REVERSED AND REMANDED

NEAL E. ABRAMS Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

LJS/dal

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